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PATENT APPLICATION

ATTORNEY DOCKET NO. AUS9-2001-0372-US1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): McBrearty et al.	Confirmation No.: 1470
Application No.:09/996,125	Examiner: J. Swearingen
Filing Date: Nov. 28, 2001	Group Art Unit: 2145
Title: System And Method For Indicating Whether A Document Is Cached	

Mail Stop Appeal Brief-Patents
Commissioner For Patents
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Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on __July 11, 2006____ .

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)
for the total number of months checked below:

( )	one month	$120.00
( )	two months	$450.00
( )	three months	$1020.00
( )	four months	$1590.00

( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **09-0447** the sum of **$500.00**____ . At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 09-0447   pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 09-0447   under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Number of pages: /8

Typed Name: Edmond A. DeFrank

Signature:_____

Rev 12/04 (Apbrief)

Respectfully submitted,

McBrearty et al.

By _____

Edmond A. DeFrank
Attorney/Agent for Applicant(s)
Reg. No.   37,814

Date: 09-01-2006

Telephone No.: (818) 885-1575

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Number of pages: 18

Typed Name: Edmond A. DeFrank

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Date: 09-01-2006

Telephone No.: (818) 885-1575

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 09/996,125
Filing Date.. November 28, 2001
Inventor .... McBrearty et al.
Assignee .... International Business Machines Corporation
Group Art Unit 2145
Examiner.. J. Swearingen
Attorney's Docket No. AUS9-2001-0372-US1
Confirmation No.. 1470
Title:................ System And Method For Indicating Whether A Document Is Cached

BRIEF OF APPELLANT

To: Mail Stop Appeal Brief-Patents
            Commissioner of Patents
            P.O. Box 1450
            Alexandria VA 22313-1450

From: Edmond A. DeFrank (Tel. 818.885.1575; Fax 818.885.5750)
            Law Offices of Edmond A. DeFrank
            20145 Via Medici
            Northridge, CA 91326

        Appellant appeals from the final rejection, mailed April 11, 2006, of claims 1-

3, 5-15 and 17-29. The Commissioner is authorized to charge the fee required

under 37 C.F.R. § 41.20(b)(2) to Deposit Account No. 09-0447.

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By   Signature

AUS9-2001-0372-US1
Serial No. : 09/996,125
Brief of Appellant

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I. REAL PARTY IN INTEREST

The real party in interest is the assignee, International Business Machines Corporation.

II. RELATED APPEALS AND INTERFERENCES

Appellant's undersigned legal representative and the assignee of the pending application are aware of no appeals or interferences which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF THE CLAIMS

Claims 1-3, 5-15 and 17-29 are pending and stand finally rejected. Appellant appeals the rejection of claims 1-3, 5-15 and 17-29.

IV. STATUS OF AMENDMENTS

No amendments have been filed after the final rejection mailed April 11, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the subject matter defined in the independent claims and dependent claims involved in the appeal follow with respect to exemplary illustrative embodiments of the specification and figures.

Referring to independent claims 1, 13 and 23, exemplary methods are shown in FIGS. 2-9 and described at paragraphs [0055-0081] of the specification of the present case, U.S. Patent Publication No. 2003/0101234. Claim 1 is a management process operating on a computer system that has cached documents stored on the computer system (see FIGS. 2-3 and paragraphs [0055-0061]). The process includes displaying cache status information about the cached documents when a user digitally points to an address associated with one or more of the cached documents (see FIGS. 4-5 and paragraphs [0070-0071]), displaying a percentage of the document that was previously cached with the cache status information (see FIGS. 4-5 and paragraphs [0070-0071]) and allowing the user to digitally point to selected designated potions of the cached document (see FIG. 4A

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and 4B and paragraph [0070]) and only loading the designated portions of the cached document (see FIGS. 5-7 and paragraphs [0076-0077]).

Claim 13 is a computer system having a browser operating thereon for displaying documents.   The computer system includes a memory device that selectively caches the documents (see FIGS. 2-3 and paragraphs [0055-0061]), a module that tracks status information during caching of the documents (see FIGS. 4-5 and paragraphs [0070-0071]), a cache status device enabled by the module for displaying the status information when a user digitally points to an address associated with one or more the cached documents (see FIG. 4A and 4B and paragraph [0070]), wherein the cache status device includes a permanent display that is highlighted when a Web page is cached (see FIGS. 4-5 and paragraphs [0070-0071]) and wherein cache status information includes percentage of the document that was previously cached (see FIG. 4A and 4B and paragraph [0070]), a setup module that allows a user to select a method of displaying the cache indicator through at least one of a dialog box that is displayed at predefined intervals or a dialog box that is displayed when a Web page is actually cached (see FIGS. 4-5 and paragraphs [0070-0072]) and a load module that allows the user to digitally point to selected designated potions of the cached Web page and only loading the designated portions of the cached Web page (see FIGS. 4-7 and paragraphs [0076-0077]).

Claim 23 is a computer-readable medium having computer-executable instructions operating on a computer system for managing document navigation. The computer-executable instructions operating on a computer system include an indicia module that tracks status information during storage of the documents (see FIGS. 2-3 and paragraphs [0055-0061]), a display device for displaying the status information when a user digitally rolls a cursor over an address associated with one or more of the stored documents (see FIGS. 4-5 and paragraphs [0070-0071]), a percentage display device that displays a percentage of the document that was previously cached (see FIG. 4A and 4B and paragraph [0070]) and a load module that allows the user to digitally point to selected designated potions of the cached document and only loading the designated portions of the cached document (see FIGS. 5-7 and paragraphs [0076-0077]).

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Referring specifically to FIGS. 4-5 and paragraphs [0070-0071], support for claims 1, 13 and 23 of the claimed subject matter include accessing the cache status information when the user rolls a cursor 425 over one or more of the URL addresses 420 and. The user is then provided with a cache status bar 430 that holds the available status indicator 270, the percentage status indicator 272 and the date status indicator 274. In addition, the URL address of the document that the user is pointing to could be included in the cache status bar 430 to show that the URL is in the cache. A flag is used to show this, such as flashing the URL or displaying the word "cached" in the status bar 430. Referring to FIG. 5A, after the user selects the web page and it's loaded, a cache indicator 502 appears in the Web browser 220, and is displayed only when the Web page is cached. In claim 13, a permanent display is highlighted when the page is cached. The cache indicator 502 may be displayed as a dialogue box prior to displaying the Web page 410, or displayed at pre-determined time intervals, or a user may be able to select the location or method of displaying the cache indicator 502 through the setup location/menu of the application GUI.

In addition, referring specifically to FIGS. 4-7 and paragraph [0076], support for claims 1, 13 and 23 of the claimed subject matter include providing load options to the user after the user views the cache status information 430 or from menu 700, and before the web page is loaded. The load options 701 are an extension of the load menu 700 and include several options. For example, the user is given the following options: 1) load the cached document 702; 2) load designated portions of the document either from the cache or with newly loaded and "fresh" content 704; or 3) load a completely new or "fresh" document 706.

The claimed invention helps a user make an informed decision about World Wide Web browsing by solving the problem of current browsers of not providing enough status information on the documents or pages that are cached. For instance, some users hesitate to visit certain URLs for fear the documents located at the URLs will take too long to load due to their slow network connection. If the users were aware of when the cached page was cached or what percentage of the page was cached this would help them make an informed decision and enhance their browsing experience.

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VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

     A.   The 103 rejection of claims 1-3, 5, 7-15, 17, 19-25 and 27-29.

     B.   The 103 rejection of claims 6, 18 and 26.

VII.   ARGUMENT

     A.   The rejections under 35 U.S.C. § 103(a) should be withdrawn because claims 1-3, 5-15 and 17-29 contain features that are not disclose, taught or suggested by the cited references.

On page 2 of the April 11, 2006 Office Action, the Examiner rejected claims 1-3, 5, 7-15, 17, 19-25 and 27-29 over Acharya et al. (U.S. Paten No. 6,826,593) in view of Gong (U.S. Patent No. 6,243,089). On page 4 of the April 11, 2006 Office Action, the Examiner rejected claims 6, 18 and 26 over Acharya et al. (U.S. Paten No. 6,826,593) in view of Gong (U.S. Patent No. 6,243,089) and further in view of Banga et al. (U.S. Patent Publication No. 2001/0020248).

Both of the rejections under 35 U.S.C. § 103(a) should be withdrawn because the elements of the Appellants' claimed invention are not disclosed, taught or suggested by the cited references. According to case law and the MPEP, all of the claimed elements of an Appellant's invention must be considered. (In re Kotzab, 55 USPQ 2d 1313, 1318 (Fed. Cir. 2000). *MPEP 2143.*). If <u>one</u> of the elements of the Appellant's invention is missing from or not taught in the cited references and the Appellant's invention has advantages not appreciated by the cited references, then no prima facie case of obviousness exists. (*MPEP 2143.03*). The Federal Circuit Court has stated that it was an error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. In Re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Specifically, the Appellants submit that the combination of Acharya et al. with Gong and/or Banga et al. fail to disclose, teach, or suggest the elements of

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claimed invention. For example, Gong discloses a status bar and Acharya et al. disclose "...allowing a user to receive a user-selected version of a file..." (see col. 4, lines 21-23 of Acharya et al.). However, Gong combined with Acharya et al. and/or Banga et al. do not disclose, teach, or suggest allowing the user to digitally point to selected designated potions of the cached document and only loading the designated portions, like the Appellants' claimed invention. Instead, Acharya et al. in combination with Gong and Banga et al. disclose allowing the user to select different complete versions of the files (see col. 4, lines 46-63 of Acharya et al.). This is unlike the Appellants' claimed invention which allows selecting designated potions of the cached document and only loading the designated portions in response to the user digitally pointing to selected designated potions of the cached document.

Although the Examiner used the cited references to allegedly find features of the Appellants claimed invention, on page 5 of the November 2, 2005 Office Action, the Examiner relied on an incorrect interpretation of the cited references. Namely, the Examiner incorrectly stated that "It is the Examiner's contention that the selection of a hyperlink consists of a user digitally pointing [selection of] to an address [hyperlink]." This contention is incorrect because selecting a hyperlink is not the same as digitally pointing to a hyperlink. There is a very distinct difference between clicking on an object and digitally pointing to it (hovering over it or using a "mouseover"). For instance, webopedia.com describes digitally pointing (hovering the mouse or a "mouseover") as a "JavaScript element that triggers a change on an item (typically a graphic change, such as making an image or hyperlink appear) in a Web page when the pointer passes over it."

In addition, Wikipedia.com states that a "[M]ouseover is the term used to indicate the text that appears next to your mouse pointer when you hold a computer mouse over any screen object that is an active link, or over some other GUI element or widget that is capable of performing an action, such as an icon or command button...It is also a web design term used to describe any effect that appears on a website that occurs when you hold a computer mouse over a hyperlink or linking image." (http://en.wikipedia.org/wiki/Mouseover).

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Clearly, unlike the cited references, allowing the user to digitally point to selected designated potions of the cached document and only loading the designated portions is very different from simply selecting a hyperlink and loading everything, like the cited references. Therefore, because the Examiner relied on an incorrect contention that "selecting" or "clicking" on an object in the combined cited references is the same as the Appellants' claimed allowing the user to digitally point to selected designated potions of the cached document and only loading the designated portions, the cited references cannot render the claims obvious since they are missing elements of the Appellants claimed invention. Consequently, the Appellants respectfully submit, among other things, that combination of Acharya et al. with the Gong and/or Banga et al. references does not disclose the claimed element of allowing the user to digitally point to selected designated potions of the cached document and only loading the designated portions.

Further, the Examiner clearly used the benefit of hindsight. Improper hindsight occurs when knowledge and advantages from the Applicant's disclosure is used or words or phrases are arbitrarily picked and chosen from references to recreate the Applicant's invention. Crown Operations International, Ltd. v. Solutia, Inc., 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In particular, the combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of hindsight is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Impermissible hindsight was used by the Examiner when he improperly stated that "It is the Examiner's contention that the selection of a hyperlink consists of a user digitally pointing [selection of] to an address [hyperlink]." It appears that the Examiner cited an element in Acharya et al. that is related to, but clearly different, from the Appellants' feature to reject the claims. This is impermissible hindsight because although "...the opportunity to judge by hindsight is particularly tempting...the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses combined references that do not explicitly disclose the exact elements of the invention, which is the case here. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). Since

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hindsight cannot be used to support the rejections, the combined cited references cannot render the Appellants' invention obvious and the rejection is improper and should be withdrawn. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc. Accordingly, this failure of the cited references to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (MPEP 2143).

With regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on at least the same basis. (MPEP § 2143.03).

Appellants respectfully submit that the claims are allowable for at least the above-mentioned compelling reasons.

B.   Conclusion

In view of the foregoing, reversal of the rejections of the claims is respectfully requested. For any one of the above-stated reasons, the rejections of the respective claims should be reversed. In combination, the above-stated reasons overwhelmingly support such reversal. Accordingly, Appellant respectfully requests that the Board reverse the rejections of the claims.

Respectfully submitted,

Date: <u>September 1, 2006</u>   Attorney:

Edmond A. DeFrank
Reg. No. 37,814

AUS9-2001-0372-US1
Serial No. : 09/996,125
Brief of Appellant

PAGE 11/18 * RCVD AT 9/1/2006 2:45:06 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/37 * DNIS:2738300 * CSID:818 885 5750 * DURATION (mm-ss):03-48

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VIII.   CLAIMS APPENDIX

1   1. (previously presented) A management process operating on a computer

2   system that has cached documents stored on the computer system, the process

3   comprising:

4   displaying cache status information about the cached documents when a

5   user digitally points to an address associated with one or more of the cached

6   documents;

7   displaying a percentage of the document that was previously cached with

8   the cache status information; and

9   allowing the user to digitally point to selected designated potions of the

10   cached document and only loading the designated portions of the cached

11   document.

1   2. (original) The process of claim 1, wherein the user rolls a cursor over

2   the address to digitally point to the address.

1   3. (original) The process of claim 1, wherein the cache status information

2   includes document availability.

1   4. (canceled).

1   5. (original) The process of claim 1, wherein cache status information

2   includes the date the document was cached.

1   6. (previously presented) The process of claim 1, further comprising

2   analyzing a current file size of the document and data associated with the

3   document and comparing it to an actual file size of the cached document and

4   reporting the comparison as the percentage of the document cached.

1   7. (original) The process of claim 1, further comprising creating a time

2   stamp associated with the computer system and reporting it as the date the

3   document was cached.

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1   8. (original) The process of claim 1, wherein the document is a World
2   Wide Web page that is accessed by an Internet browser and the addresses are
3   uniform resource locators pointing to other World Wide Web pages.

1   9. (original) The process of claim 1, further comprising allowing a user to
2   selectively choose to load the cached documents from at least one of a local
3   storage area or from a network connection.

1   10. (original) The process of claim 1, further comprising providing load
2   options including at least one of loading the cached document, loading
3   designated portions of the document from the cache or loading a completely
4   new document.

1   11. (original) The process of claim 1, further comprising providing visual
2   indicia to distinguish between the portions of the document that are cached and
3   new.

1   12. (original) The process of claim 11, wherein the visual indicia is a
2   color coded scheme.

1   13. (previously presented) A computer system having a browser
2   operating thereon for displaying documents, comprising: a memory device that
3   selectively caches the documents;
4   a module that tracks status information during caching of the documents;
5   a cache status device enabled by the module for displaying the status
6   information when a user digitally points to an address associated with one or
7   more the cached documents, wherein the cache status device includes a
8   permanent display that is highlighted when a Web page is cached and wherein
9   cache status information includes percentage of the document that was
10   previously cached;
11   a setup module that allows a user to select a method of displaying the
12   cache indicator through at least one of a dialog box that is displayed at

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13   predefined intervals or a dialog box that is displayed when a Web page is
14   actually cached; and
15   a load module that allows the user to digitally point to selected
16   designated potions of the cached Web page and only loading the designated
17   portions of the cached Web page.

1   14. (original) The computer system of claim 13, wherein digitally pointing
2   to the address includes rolling a cursor over the address.

1   15. (original)   The computer system of claim 13, wherein the cache
2   status information includes document availability.

1   16. (canceled).

1   17. (original)   The computer system of claim 13, wherein cache status
2   information includes the date the document was cached.

1   18. (previously presented)   The computer system of claim 13, wherein
2   the module analyzes a current file size of the document and data associated with
3   the document, compares it to an actual file size of the cached document and
4   reports the comparison as the percentage of the document cached.

1   19. (original) The computer system of claim 13, wherein the document is
2   a World Wide Web page that is accessed by an Internet browser and the
3   addresses are uniform resource locators pointing to other World Wide Web
4   pages.

1   20. (original) The computer system of claim 13, further comprising load
2   options including at least one of loading the cached document, loading
3   designated portions of the document from the cache or loading a completely
4   new document.

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1   21. (original) The computer system of claim 13, further comprising visual

2 indicia to distinguish between the portions of the document that are cached and

3 new.

1   22. (original) The computer system of claim 21, wherein the visual

2 indicia is a color coded scheme.

1   23. (previously presented) A computer-readable medium having

2 computer-executable instructions operating on a computer system for managing

3 document navigation, comprising:

4   an indicia module that tracks status information during storage of the

5 documents; and

6   a display device for displaying the status information when a user digitally

7 rolls a cursor over an address associated with one or more of the stored

8 documents;

9   a percentage display device that displays a percentage of the document

10 that was previously cached; and

11   a load module that allows the user to digitally point to selected

12 designated potions of the cached document and only loading the designated

13 portions of the cached document.

1   24. (original) The computer-readable medium of claim 23, wherein the

2 display device includes a status bar for displaying the status information when a

3 user digitally rolls a cursor over an address associated with the stored

4 documents.

1   25. (original) The computer-readable medium of claim 23, wherein the

2 document is a World Wide Web page that is accessed by an Internet browser

3 and the addresses are uniform resource locators pointing to other World Wide

4 Web pages.

1   26. (previously presented) The computer-readable medium of claim 23,

2 wherein the module analyzes a current file size of the document and data

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3   associated with the document, compares it to an actual file size of the cached
4   document and reports the comparison as the percentage of the document
5   cached.

1   27. (original)   The computer-readable medium of claim 23, further
2   comprising load options including at least one of loading the cached document,
3   loading designated portions of the document from the cache or loading a
4   completely new document.

1   28. (original)   The computer-readable medium of claim 23, further
2   comprising visual indicia to distinguish between the portions of the document
3   that are cached and new.

1   29. (original)   The computer-readable medium of claim 28, wherein the
2   visual indicia is a color coded scheme.

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IX.   <u>EVIDENCE APPENDIX</u>

Copies of evidence are not enclosed.

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X. RELATED PROCEEDINGS APPENDIX

Appellants are not aware of any related proceedings.